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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,083	07/20/2001	Kathryn H. Britton	RSW9 20000166US1	2405

7590 08/23/2004  
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EXAMINER

BLACKWELL, JAMES H

ART UNIT PAPER NUMBER

2176

DATE MAILED: 08/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/910,083	<b>Applicant(s)</b> BRITTON ET AL.	
	<b>Examiner</b> James H Blackwell	<b>Art Unit</b> 2176	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 27-28, and 30-32 is rejected under 35 U.S.C. 102(b) as being anticipated by Nagami (U.S. Patent No. 5,548,508).

In regard to independent Claim 1, Nagami teaches a machine translation apparatus for translating a document including at least one tag, wherein the machine translation apparatus comprises a definition file (“... ***specifying one or more annotations***”) for converting the tag into supplementary translation information for a machine translation operation; a supplementary translation information adding unit for adding the supplementary translation information for the tag, into the document (“... ***inserting one or more selected ones of the specified annotations in a particular document, thereby preparing the particular document for enhanced transcoding***”) in accordance with the definition file; and a machine translation engine for carrying out the machine translation operation after accepting the document having the supplementary translation information (Col. 2, lines 4-14).

In regard to dependent Claim 2, Nagami teaches a supplementary translation information-adding unit for adding the supplementary translation information for the tag,

into the document (Col. 2, lines 9-11; compare with Claim 2, “... ***the including step occurs programmatically***”).

In regard to dependent Claim 3, Nagami teaches a machine translation engine for carrying out the machine translation operation after accepting the document having the supplementary translation information (Col. 2, lines 12-14; compare with Claim 3, “...***transcoding the particular document using the inserted annotations***”).

In regard to dependent Claim 4, Nagami teaches a definition file for converting the tag into supplementary translation information for a machine translation operation (Col. 2, lines 7-9; compare with Claim 4, “... ***at least one of the specified annotations is specified separately from the particular document***”).

In regard to dependent Claim 5, Nagami teaches a supplementary translation information-adding unit for adding the supplementary translation information for the tag, into the document (Col. 2, lines 9-11; compare with Claim 5, “... ***at least one of the specified annotations is specified inline within the particular document***”).

In regard to independent Claim 27, Nagami teaches that a writer (operator) can directly describe the supplementary translation information for carrying out the machine translation (machine translation engine) into the document. Nagami also teaches that these documents are SGML documents which are structured. This suggests that a writer (operator) is present to submit a structured document for translation to a translating engine, which receives it for processing (“... ***receiving a request for a structured document***”). To assist in the translation, Nagami teaches a file containing supplementary translation information, which accompanies the document to be

translated. This suggests that the translation engine would need to be able to access this file to apply it to the document to be translated (“...**locating one or more annotation files which contain annotations which are pertinent to the request**”).

Nagami also teaches a supplementary translation information-adding unit for adding the supplementary translation information for the tag, into the document (Col. 2, lines 9-11; compare with Claim 27, “... **inserting the pertinent annotations into the structured document, thereby creating an annotated document**”).

In regard to dependent Claim 28, Nagami teaches that the supplementary translation information-adding unit adds the supplementary translation information to the document in accordance with the definition file (“... **applying the annotations in the annotated document, thereby creating a modified document**”). The machine translation engine carries out the machine translation operation by accepting the document having the supplementary translation information. Therefore, a precise translation can be carried out without using human knowledge or the common sense of an operator (see Abstract; compare with Claim 28, “... **transcoding the modified document, thereby creating a transcoded document**”).

In regard to independent Claim 30 (and similarly independent Claims 31, and 32), Nagami teaches that a writer (operator) can directly describe the supplementary translation information for carrying out the machine translation (machine translation engine) into the document. Nagami also teaches that these documents are SGML documents which are structured. This suggests that a writer (operator) is present to submit a structured document for translation to a translating engine, which receives it for

processing (“... **receiving a request for a structured document**”). To assist in the translation, Nagami teaches a file containing supplementary translation information, which accompanies the document to be translated. This suggests that the translation engine would need to be able to access this file to apply it to the document to be translated (“... **locating one or more annotation files which contain annotations which are pertinent to the request**”). Nagami teaches that the supplementary translation information-adding unit adds the supplementary translation information to the document in accordance with the definition file (“... **applying the pertinent annotations to the structured document, thereby creating a modified document**”). Nagami also teaches that the machine translation engine carries out the machine translation operation by accepting the document having the supplementary translation information. Therefore, a precise translation can be carried out without using human knowledge or the common sense of an operator (see Abstract; compare with Claim 30 (and similarly Claims 31, and 32), “...**transcoding the modified document, thereby creating a transcoded document**”).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-26, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagami.

In regard to dependent Claims 6-26, the claimed *at least one of specified annotations* set forth in Claims 6 through 26 would have been obvious to one of ordinary skill in the art at the time of the invention over Nagami's teaching (Col. 8, lines 39-55) because the "specified annotations" constitute nothing more than non-functional descriptive data. Since the claimed invention does not operate on this data, the data imparts no functionality, and is therefore obvious over any other data.

In regard to dependent Claim 29, Nagami does not specifically teach *the step of sending the transcoded document to a device, which issued the request*. However, it would have been obvious to one of ordinary skill in the art at the time of invention to realize that at the conclusion of the translation process taught by Nagami (see above) would have been a translated document that would have been available to the writer (operator) that submitted the document to be translated. The benefit would have been to receive a precisely translated document.



**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Blackwell whose telephone number is 703-305-0940. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Blackwell  
08/019/04

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER